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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/040,798	03/18/1998	VIKTOR KELLER	P5550	2256
24492	7590	05/27/2004	EXAMINER WONG, STEVEN B	
THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED SUBSIDIARY OF CALLAWAY GOLF COMPANY P.O. BOX 901 425 MEADOW STREET CHICOPEE, MA 01021-0901			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/040,798	Applicant(s) KELLER ET AL.	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims Rejection – 35 USC 112

The amendments to the claims have overcome the rejections under 35 USC 112.

Claims Rejections – 35 USC 102

Claims 38 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan et al. (5,356,941). Note the rejection set forth in Paper No. 30.

Claims 42-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Cavallero (5,759,676). Note the rejection set forth in Paper No. 30.

Claims Rejections – 35 USC 103

Claims 14-20, 23, 29-34, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941). Note the rejections set forth in Paper No. 30.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941) and Molitor (4,674,751). Note the rejections set forth in Paper No. 30.

Claims 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (5,334,673) in view of Sullivan (5,356,941) and “Bayer – RIM Part and Mold Design” (polyurethanes). Note the rejections set forth in Paper No. 30.

Claims 14, 18, 21, 22 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavallero (5,759,676) in view of Sullivan (5,356,941). Note the rejections set forth in Paper No. 30.

Double Patenting

Claims 38-41 and 44 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 40, 41, 43, 44 and 48 of copending Application No. 09/877,600. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1-37, 42 and 43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 90-11, 13, 14, 16-39, 46 and 47 of copending Application No. 09/877,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention and the '600 application both claim the process of making a golf ball comprising making at least a core and a cover component by mixing two or more reactants. The instant application produces a product with a flex modulus from 5 to 310 kpsi in a reaction time of 5 minutes or less. The '600 application produces a product with a flex modulus from 1 to 310 kpsi in a reaction time of less than 2 minutes. Varying the reaction time of the product is an obvious modification of the '798 application that would promote the desired and/or optimal characteristics of the product.

Response to Arguments

The applicant's remarks filed March 16, 2004 have been fully considered but are not deemed to be persuasive. Regarding claims 38 and 44, the applicant contends that the ball of Sullivan '941 is directed to a game ball whereas the claims recite a golf ball. However, this is

not persuasive as Sullivan merely mentions the softball and baseball as exemplary embodiments and does not limit the game ball to those embodiments. Attention is directed to column 1, lines 5-17 stating that the invention is directed to game balls which clearly would include the recited golf balls. Further, the limitation for the ball to be a "golf" ball is solely set forth in the preamble of the claim. If the body of the claim describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention, the preamble is generally not limiting.

Regarding claims 42-44, the applicant contends that Cavallaro lacks the teaching for the recited reaction time of 5 minutes or where the reactants are obtained from recycled polyurethane/polyurea. This argument is not persuasive as the recited reaction time and reactants relate to the process of making the golf ball. See MPEP 2113. "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claims 14-20, 23, 29-344, 37 and 40, the applicant contends that the examiner has not provided a reason to combine the teachings of Wu and Sullivan. It would have been obvious to one of ordinary skill in the art to form the ball of Wu using reaction injection molding as Sullivan teaches this a well known method for molding polymers to form the layers of a ball.

Regarding claim 35, the combination of Wu in view of Sullivan provides the teaching for a ball that is formed by reaction injection molding.

Regarding claims 14, 18, 21, 22 and 24-28, similar to the rejection over the combination of Wu in view of Sullivan, it would have been obvious to one of ordinary skill in the art to

provide manufacture the ball of Cavallaro using reaction injection molding as Sullivan teaches this is a well known method for molding polymers to form the layers of a ball.

The double patenting rejections have been maintained as the applicant has neither supplied the requisite Terminal Disclaimer nor amended the claims to overcome the rejections.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
May 25, 2004